

REMARKS

Claims 1-22, 25, and 27 are active in the present application.

The rejection of Claims 14-22 and 25 under 35 U.S.C. §112, second paragraph, is traversed.

At the outset, Applicants must confess that the Examiner's "insufficient antecedent basis" rejection appears to be, at best, without merit. For example, the Examiner rejects Claim 14 asserting that there is a lack of antecedent basis for "expression of a gene encoding phosphoribosyl pyrophosphate amidotransferase or a phosphoribosyl pyrophosphate synthase is increased" (see paper number 20, page 2, second paragraph of numbered section 5). However, this phrase does not even appear in Claim 14, which is reproduced for the Examiner's convenience:

The method according to claim 13, wherein expression of a gene encoding an enzyme involved in purine nucleoside biosynthesis is increased in said microorganism and said enzyme involved in purine nucleoside biosynthesis is a phosphoribosyl pyrophosphate amidotransferase or a phosphoribosyl pyrophosphate synthase.

Therefore, Applicants wonder how a phrase that does not even appear in a claim can lack sufficient antecedent basis. Applicants further note that a similar problem plagues this ground of rejection for Claims 15, 16, 22, and 25. Moreover, Applicants remind the Examiner that MPEP §2173.05(e) states: "Inherent components of elements recited have antecedent basis in the recitation of the components themselves." Therefore, even if there is any remote basis to the Examiner's antecedent basis rejection, Applicants submit that the claims are compliant with 35 U.S.C. §112, second paragraph, especially when one is mindful of MPEP §2173.05(e).

In the Office Action, the Examiner has rejected Claims 16 and 22 as being indefinite for failure to recite the specific enzyme which is desensitized by desensitization of feedback

inhibition (Claim 16) or which is derepressed (Claim 22). However, Applicants note that Claims 16 and 22 depend from Claim 15, which defines the specific enzyme as either a phosphoribosyl pyrophosphate amidotransferase or a phosphoribosyl pyrophosphate synthase. Accordingly, Applicants submit that Claims 16 and 22 do, in fact, recite the specific enzymes and thus justify full compliance with 35 U.S.C. §112, second paragraph.

Accordingly, Applicants request withdrawal of this ground of rejection.

Regarding the claim objection as reciting non-elected subject matter, Applicants remind the Examiner that MPEP §803.02 *compels* examination of all the members of the Markush group in a situation like the present case. MPEP §803.02 states:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner ***must*** examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.
(*emphasis added*)

In the present application, Applicants submit that the members of the Markush group are sufficiently few in number (only nine!!) so as not to constitute a serious burden upon the Examiner. Moreover, Applicants submit that within the context of the present invention, the members of the Markush group are so closely related (i.e., facilitate production of a purine nucleoside by fermentation) so as not to constitute a serious burden upon the Examiner. Therefore, regardless of which standard under MPEP §803.02 is applied, for *each* of the reasons the Examiner ***must*** examine all the members in the Markush group in the claim on the merits.

Accordingly, no further amendment is believed to be necessary and this ground of objection should be withdrawn.

Applicants note that all of the presently pending claims have been searched on the merits and no amendments have been made in response to the outstanding Office Action. Therefore, any new ground of rejection cannot be reasonably considered to have been necessitated by Applicants' amendment. Accordingly, it is expected that any new ground of rejection would be in a new non-final Office Action.

Applicants submit that the present application is in condition for allowance. Early notification to this effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Stephen G. Baxter
Attorney of Record
Registration No. 32,884

Vincent K. Shier, Ph.D.
Registration No. 50,552



22850

(703) 413-3000
Fax #: (703) 413-2220
NFO/VKS